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10602

EXAMINER

10602

MICHAEL E DERGOSITS
DERGOSITS AND NOAH
FOUR EMBARCADERO CENTER
SUITE 511
SAN FRANCISCO CA 94111

ART UNIT

PAPER NUMBER

23

DATE MAILED:

10/05/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 7/28/94 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 3 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☒ Notice of References Cited by Examiner, PTO-892.
- ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
- ☐ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐

Part II SUMMARY OF ACTION

- ☒ Claims 14-24, 26-29, 33-34, 118-133 are pending in the application.
Of the above, claims are withdrawn from consideration.
- ☐ Claims have been cancelled.
- ☐ Claims are allowed.
- ☒ Claims 14-24, 26-29, 33-34, 118-133 are rejected.
- ☐ Claims are objected to.
- ☐ Claims are subject to restriction or election requirement.
- ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
- ☐ Formal drawings are required in response to this Office action.
- ☐ The corrected or substitute drawings have been received on Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
- ☐ The proposed additional or substitute sheet(s) of drawings, filed on has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
- ☐ The proposed drawing correction, filed has been ☐ approved; ☐ disapproved (see explanation).
- ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. ; filed on
- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
- ☐ Other

EXAMINER'S ACTION

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1. Claims 14-24, 26-29, 33-34, 118-133 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 5,237,157. Although the conflicting claims are not identical, they are not patentably distinct from each other as described in the Office action mailed 10/05/94.

As mentioned in the previous action, the patented claims recite a method for previewing information from a music product for sale including entering a subscriber code at a kiosk, identifying the music product (including the use of a bar code reader) by supplying a product code from the music product's packaging, and interactively reproducing portions of the product. While the instant claims do not recite the source of the identification of the music product to the kiosk, deletion thereof, with the corresponding loss of function would have been obvious to those of ordinary skill in the art. With regard to the recitations in the instant claims concerning the collection of frequency data, note the recitations of gathering market research data in patented claim 11. While patented claim 11 also includes recitations of gathering demographic information, again, the deletion of this feature with the corresponding loss of function would have been obvious to those of ordinary skill in the art.

As applicant has not yet filed a terminal disclaimer, this grounds of rejection has not been overcome.

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2. The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

3. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

4. Claims 14-17, 22-23, 26 and 33 are rejected under 35 U.S.C. § 103 as being unpatentable over Riddell et al. (GB 2,218,081) in view of Bradt et al. and Stern et al. as applied in the Office action mailed 10/05/94.

Initially, applicant traverses this ground of rejection by asserting that "no one of the references discloses all of the elements of the claimed invention". However, the references were applied in combination under 35 USC 103, not 102. Attacking each of

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the references individually, in a vacuum, when the rejection was based on a combination of the references does not provide a showing of non-obviousness.

With respect to Riddell, applicant argues that its primary purpose is the sale or rental of videocassettes. However, Riddell, on page 2, specifically teaches that compact discs, audio cassettes and digital audio cassettes are included in the media handled by the device. Concerning the preview mode of Riddell, this is specifically described at least in the abstract, the third full paragraph of page 2, the second full paragraph of page 4 and the description of fig. 1 on page 5 of Riddell. Although applicant asserts that this description is not enabling, applicant has not supported this bald assertion. While applicant argues that Riddell does not have any way of choosing among musical selections and controlling the preview playback, Riddell alone is not relied on alone in this rejection. As mentioned in the previous Office action, Stern is seen to suggest the obviousness of selecting among plural musical selections. Further, "control" of the playback is broad enough to read on merely initiating the preview process, which is already taught by Riddell. Note the description of fig. 1 of Riddell. Concerning the "subscriber identification" argued by applicant, it is not seen where the claims require the "subscriber" to provide pertinent demographic data to the preview service company as argued. According to the claims, the subscriber is merely identified. As mentioned in the previous action, this is met by the use of a credit card in Riddell, which necessarily identifies and authorizes the user.

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Concerning Bradt, the examiner did not rely on Bradt to teach previewing as this is already taught in Riddell. The previewing in Bradt was mentioned merely to establish that the teachings of Bradt are in the same environment as the invention and in the same environment as Riddell. Regarding Bradt and Stern, applicant argues that these references are so different that there would be no motivation to combine and that nothing in the references suggests their combination. However, the references alone are not the only source of motivation for combining teachings. The knowledge generally available to those of ordinary skill in the art can also provide the necessary motivation. As Bradt and Stern are both in the same environment as the invention and in the same environment as Riddell, i.e. previewing recorded information, they certainly represent analogous art. Further, as mentioned in the prior Office action, Bradt teaches user verification prior to other operations of the device, including preview, which provides the obvious advantage of limiting access to the device to those that can actually complete a transaction so that the device is not tied up in unproductive activities. This obvious advantage, readily recognized by those of ordinary skill in the art when viewing Bradt, provides the motivation to modify Riddell. This motivation is not based on the instant claims or the specification and thus cannot be said to represent improper hindsight.

With regard to Stern, again, Stern represents analogous art. While applicant may characterize Riddell and Bradt as dispensing systems, this does not give fair credit to the teachings of previewing contained therein. Further, applicant's reference to the "differing

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goals" of Bradt and Riddell as compared with Stern is an attempt to show incompatibility by considering only the preferred embodiments of the respective references without considering what the fair teachings would suggest to those of ordinary skill in the art. As Riddell already teaches previewing, it is not seen where the fair teachings of Stern's previewing system cannot be used to modify the previewing of Riddell even if Riddell includes other features, given proper motivation. As mentioned in the previous Office action, Stern suggests the desirability of allowing the user of the preview system to associate a desired music selection with a particular product. Considering that music products typically contain a plurality of individual tracks and considering that it is well known to release a plurality of these tracks from one product for exposure on the radio or TV, it would have been obvious to those of ordinary skill in the art to modify the preview of Riddell to include plural musical selections to choose from so as to achieve the association suggested in Stern, as successful association obviously leads to product sales.

Concerning applicant's desire for teachings of which features to preserve and which to abandon, it is not clear where this is required for a combination of the references and a showing of obviousness. While Riddell, Bradt and Stern may have different interests and even structure in achieving their desired objectives, the ability to combine references does not involve any ability to combine their specific structures.

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5. Claims 118-120, 125-128 and 133 are rejected under 35 U.S.C. § 103 as being unpatentable over Baus in view of Stern et al. as applied in the Office action mailed 10/05/94.

With respect to the combination of Baus and Stern, applicant again argues the use of impermissible hindsight, but does not show how the motivation set forth in the prior Office action could only come from applicant's own disclosure. Applicant further argues that Baus only provides written information about a product offered for sale, but this does not explain the use of audio output or video disc storage and screen display for picture sequences. Applicant then argues that Stern does not rely on bar codes as Baus does, but again, this represents an attempt to combine the specific structures of the references instead of their fair teachings to those of ordinary skill in the art. Finally, regarding the asserted "fundamental difference" between Baus and Stern, as mentioned previously, Baus does teach that the apparatus is for use in department stores, which are well known to sell music products. Moreover, Stern teaches the desirability of previewing music products as it assists in the sales of the product. As the system of Baus is a shopping aid, so too is the system of Stern.

6. Claims 18-21, 27-29, 121-124 and 129-132 are rejected under 35 U.S.C. § 103 as being unpatentable over Riddell et al. in view of Bradt et al. and Stern et al. as

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applied to claims 14-17, 22-23, 26 and 33 above and further in view of Hughes (for claims 18-21, 27-29), or Baus in view of Stern et al. as applied to claims 118-120, 125-128 and 133 above and further in view of Hughes (for claims 121-124, 129-132) as applied in the Office action mailed 10/05/94.

With respect to this grounds of rejection, applicant relies on his comments concerning Riddell, Bradt, Stern and Baus, which have been treated above. Applicant then summarily asserts that the addition of Hughes must also be improper. However, the prior Office action sets forth motivation to modify the teachings of the above mentioned references with the teachings of Hughes. As Hughes is directed to music reproduction and the teachings therein provide the obvious advantage of identifying popular selections on the system, it is not seen where the combination is improper.

7. Claims 24 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims upon resolution of the obvious-type double patenting issue.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

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A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Weinhardt whose telephone number is (703) 305-9780. The examiner can normally be reached on Monday-Friday from 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gail Hayes, can be reached on (703) 305-9711. Facsimile transmissions to this Group may be directed to (703) 305-9564 or 9565.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3800.

June 23, 1995



ROBERT A. WEINHARDT
PRIMARY EXAMINER
GROUP 2400